

### **REMARKS/ARGUMENTS**

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 1-12 are pending in the application. No claim amendments are presented, thus no new matter is added.

In the outstanding Official Action, Claims 1-12 were rejected under 35 U.S.C. § 103(a) as unpatentable over Levergood et al. (U.S. Patent No. 5,708,780, hereinafter "Levergood"), in further view of Ericsson and Wan (U.S. Patent No. 6,044,069).

The outstanding Official Action asserts that Levergood teaches all the features of Applicant's claims with the exception of a "mobile information terminal" and wherein "said unique identification information is stored in said mobile information terminal and comprises information identifying a manufacturer of the mobile information terminal."<sup>1</sup> In addressing the admitted deficiencies of Levergood, the outstanding Official Action cites Ericsson and Wan and states that it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the cited references to arrive at Applicant's claims. Applicant respectfully traverses this rejection as Wan fails to teach or suggest the claimed features for which it is asserted as a secondary reference under 35 U.S.C. § 103, and there is no suggestion or motivation to combine the references, as asserted in the outstanding Official Action.

Independent Claim 1 relates to an authentication server which executes user authentication between a mobile information terminal and a content providing server connected by data network. In advance of authentication, unique identification information stored in the mobile information terminal is registered with a customer database of an authentication server. This unique identification information, which is stored in the mobile

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<sup>1</sup> Outstanding Official Action, p. 4.

information terminal, *corresponds to the hardware of the terminal and comprises information related to a manufacturer of the mobile information terminal.*

As described in exemplary, non-limiting embodiment at p. 11 of the specification, the identification information corresponds to a “flash ID” that is stored in the flash memory of the mobile device and is unique to each mobile information terminal of each manufacturer. The specification further states “the flash ID is represented by alphanumeric characters of about 12 bytes long and consists of a maker code for identifying the maker of the mobile information terminal and an identification code unique to each mobile information terminal of each maker.”

As noted above, the outstanding Official Action admits that neither Levergood nor Ericsson teach or suggest wherein “said unique identification information is stored in said mobile information terminal and comprises information identifying a manufacturer of the mobile information terminal.”<sup>2</sup>

Specifically, independent Claim 1 recites, *inter alia*, a user authentication method, wherein

***...said unique identification information is stored and said mobile information terminal and comprises information related to a manufacturer of the mobile information terminal***

Claim 9, while directed to an alternative statutory embodiment, recites substantially similar features. Accordingly, the discussion presented below is applicable to both independent Claims 1 and 9.

In addressing the above-noted feature recited in independent Claim 1, the outstanding Official Action cites col. 6, lines 39-66 and col. 21, lines 15-30 of Wan. The cited portion of Wan describes that the cellular telephones scan frames broadcast by the base station to detect any telephone calls or pages directed to the cellular telephone. Specifically, Wan describes

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<sup>2</sup> Outstanding Official Action, p. 4.

that the mobile station compares an extracted 6-bit mobile station identifier to a 6-bit identifier value corresponding to either itself or a SIM card included in the mobile station.

However, at no point does Wan teach or suggest registering unique identification information corresponding of the hardware of said mobile information terminal with a customer database is said authentication server advance, ***wherein said unique identification information is stored and said mobile information terminal and comprises information related to a manufacturer of the mobile information terminal.***

As discussed above, the outstanding Official Action asserts that the 6-bit mobile station identifier in Wan corresponds to the claimed ***unique identification information.*** Applicant respectfully traverses this assertion.

At col. 17, lines 23-45, Wan describes that the 6-bit short page identity (SPI) value may represent 6 bits taken from the temporary mobile subscriber identity (TMSI) value, or 6 bits from the international mobile subscriber identity (IMSI) value, or may otherwise be generated based on the IMSI or TMSI values. This shortened SPI value is used so that the mobile device can more easily detect a paging signal without having to constantly expend battery power to process signals received from the wireless network.<sup>3</sup> Since the 6-bit value is generated based on some hash function or transformation performed on the aforementioned IMSI or TMSI value, the size limitation placed on the identifier does not include enough bits to include information corresponding to a manufacturer code and an identification code unique to each mobile terminal. Instead, as described col. 17, lines 23-45, the 6 bit SPI value is generated based on some portion or transformation of the mobile stations IMSI or TMSI, and is therefore essentially a selection of 6-bits from this number or is a random number generated based on one these values. The 6-bit SPI value, however, does not relate to a ***manufacturer of the mobile information terminal***, as recited in independent Claim 1.

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<sup>3</sup> Wan, cols. 1-2.

Therefore, Wan fails to teach or suggest registering unique identification information corresponding to the hardware of said mobile information terminal with the customer database is said authentication server in advance, wherein said unique identification information is stored in said mobile information terminal ***and comprises information related to a manufacturer of the mobile information terminal***, as recited in independent Claim 1.

Further, Applicant respectfully traverses the obviousness rejection based on Levergood, Ericsson and Wan because there is insufficient evidence from motivation to combine Levergood's internet server access control monitoring system, and Ericsson's method for mobile internet access by incorporating Wan's power management system for a mobile station, for the following reasons.<sup>4</sup>

The outstanding Official Action states that the proposed modification would have been obvious "to provide for users connected to the internet via mobile information terminals such as cellular phones and other hand held devices in a secure manner."<sup>5</sup> The record, however, fails to provide the required evidence of motivation for a person of ordinary skill in the art to perform such a modification. While Wan may provide a reason for generating a 6-bit short page identity value to limit the processing power use to detect a received paging signal while in standby mode, Wan fails to suggest why a person of ordinary skill in the art would be motivated to incorporate such a feature in an active internet server access control monitoring system, requiring a user's activation to request service, such as the one disclosed in Levergood. In particular, Wan uses the 6-bit short page identity value in order to reduce power consumed by a mobile station operating a standby mode by reducing the size of a

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<sup>4</sup> See MPEP 2143.01 stating "[o]bviousness can only be established by combining or modifying the teaching of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art," (citations omitted). See also MPEP 2144.08 III stating that "[e]xplicit findings on motivation or suggestion to select the claimed invention should also be articulated in order to support a 35 U.S.C. 103 ground of rejection. . . . Conclusory statements of similarity or motivation, without any articulated rational or evidentiary support, do not constitute sufficient factual findings."

<sup>5</sup> Outstanding Office Action, p. 4.

message that must be detected by the mobile station to determine that a message is intended for itself.<sup>6</sup> Wan, however, does not suggest that such a 6 bit paging value would work in a method for controlling and monitoring access to network servers, much less "to provide for users connected to the internet via mobile information terminals such as cellular phones and other hand held devices in a secure manner" in such a system. Instead, Wan simply describes a method for more efficiently receiving pages and a mobile device by generating a shorten 6-bit identifier, and fails to relate to accessing content over the internet, or user authentication, whatsoever.

In addition, Levergood and/or Ericsson is/are not concerned with allowing the user to more efficiently receive and process paging messages a mobile device. Instead, Levergood is directed to validating account between the requestor of digital content who is previously registered to receive that content by server, and authenticating such a user, and Ericsson is asserted to allowing a user to transmit a request for such content from a mobile device.<sup>7</sup> Levergood nor Ericsson does not suggest a further improvement is desired, nor that another feature should be added to improve the security or accessibility of his system. In particular, Levergood/Ericsson does not suggest to add the generation of a 6 bit identifier for receiving paging signals from a base station, such as that described in Wan.

An attempt to bring the isolated teachings of Wan, into the combination of Levergood and Ericsson would amount to improperly picking and choosing features from different references without regard of the teachings of the references as a whole.<sup>8</sup> While the required evidence and motivation that combine need not come from the applied references themselves,

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<sup>6</sup> Wan, col. 1, lines 65-col. 2, line 15.

<sup>7</sup> Levergood abstract.

<sup>8</sup> See In re Ehrreich 590 F2d 902, 200 USPQ 504 (CCPA, 1979) (stating that patentability must be addressed "in terms of what would have been obvious to one of ordinary skill in the art at the time the invention was made in view of the sum of all the relevant teachings in the art, not in view of first one and then another of the isolated teachings in the art," and that one "must consider the entirety of the disclosure made by the references, and avoid combining them indiscriminately.")

the evidence must come from *somewhere* within the record.<sup>9</sup> In this case, the record fails to support the proposed modification of Levergood and Ericsson's system.

The U.S. Court of Appeals for the Federal Circuit recently vacated a rejection under 35 U.S.C. § 103(a) based on similar grounds.<sup>10</sup> In vacating a rejection, the Court stated:

The record reflects that the examiner and the Board have managed to find motivation for substituting one type of memory for another *without providing a citation of any relevant, identifiable source of information justifying such substitution*. The statements made by the Examiner, upon which the Board relied, amount to no more than conclusory statements of generalized advantages and convenient assumptions about skilled artisans. At least under the MPEP then in effect, such statements and assumptions are inadequate to support a finding of motivation, which is a factual question that cannot be resolved on "subjective belief and unknown authority." *Lee*, 277 F.3d at 1344. Under such circumstances, with respect to core factual findings, "the Board *must point to some concrete evidence in the record in support*" of them, rather than relying on its assessment of what is "well recognized" or what a skilled artisan would be "well aware." (emphasis added)

In rejecting a claim under 35 U.S.C. § 103(a), the USPTO must support its rejection by "substantial evidence" within the record,<sup>11</sup> and by "clear in particular" evidence<sup>12</sup> of a suggestion, teaching or motivation to combine the teachings of different references. As discussed above, there is no substantial evidence, nor a clear in particular evidence, within the record of motivation for modifying Levergood and Ericsson by incorporating Wan's method for shortening the identification including paging signals. Without such motivation

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<sup>9</sup> *In re Lee*, 277 F.3d 1338, 1343-4, 61 USPQ2d 1430 (Fed. Cir. 2002) ("The factual inquiry whether to combine references ... must be based on objective evidence of record. ... [The] factual question of motivation ... cannot be resolved on subjective belief and unknown authority. ... Thus, the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion").

<sup>10</sup> *In re Beasley*, 2004 U.S. App. LEXIS 25055 (Fed. Cir. December 2004)

<sup>11</sup> *In re Gartside*, 203 F3d 1305, 53 USPQ2d 1769 (Fed. Cir. 2000) (holding that, consistent with the Administrative Procedure Act at 5 USC 706(e), the CAFC reviews the Board's decisions based on fact findings, such as 35 U.S.C. § 103(a) rejections, using the 'substantial evidence' standard because these decisions are confined to the factual record compiled by the Board.)

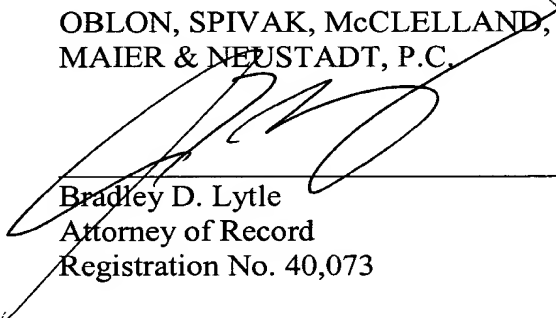
<sup>12</sup> *In re Dembiczak*, 175 F3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("We have noted that evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, although 'the suggestion more often comes from the teachings of the pertinent references.' The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular." ) (emphasis added).

and absent in proper hindsight reconstruction,<sup>13</sup> a person of ordinary skill in the art would not be motivated to perform the proposed modification, and Claims 1-12 are believed to be non-obvious and patentable over the applied references.

Consequently, in light of the foregoing comments, it is respectfully submitted that the invention defined by Claims 1-12 is patentably distinguishing over the applied references. The present application is therefore believed to be in condition for formal allowance and an early and favorable reconsideration of the application is therefore requested.

Respectfully submitted,

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<sup>13</sup> See MPEP 2141, stating, as one of the tenets of patent law applying to 35 USC 103, that "[t]he references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention."